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26/021 Hogan Lovells US LLP 1999 AVENUE OF THE STARS SUITE 1400 LOS ANGELES, CA 90067	7590 11/23/2010		<div>EXAMINER</div> <div>SANTILAGO CORDERO, MARIVELISSE</div> <div>ART UNIT 2617</div> <div>PAPER NUMBER</div>	
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/538,165  
Filing Date: June 08, 2005  
Appellant(s): HIDAKA, HIROYUKI

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Lawrence McClure  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 10/13/2010 appealing from the Office action mailed 4/13/2010.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claim 3, Claim 4, Claim 7, and Claim 8.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN

REJECTIONS.” New grounds of rejection (if any) are provided under the subheading “NEW GROUNDS OF REJECTION.”

**(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant’s brief.

**(8) Evidence Relied Upon**

Appellant’s Admitted Prior Art

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 3-4 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Appellant’s Admitted Prior Art (hereinafter “AAPA”).

Regarding claim 3, AAPA discloses a wireless communication terminal (Background Art: page 1, line 25 through page 2, line 7), which performs wireless communication using each of a first communication protocol and a second communication protocol (Background Art: page 1, line 25 through page 2, line 7; note the 1xEVDO and CDMA2000 1x, respectively) and enables to be in an idle state with both protocol (Background Art: page 2, lines 17-24), comprising:

a setting section that sets a suspend time (Figs. 3A-3B and 4; note that this figures are Prior Art) for detecting an incoming call from a base station (Figs. 3B and 4; note the “page”) using the first communication protocol (Fig. 3B and 4; note the 1xEVDO) subsequent to completion of communication with the base station using the first communication protocol

(Background Art: page 3, lines 4-11; page 12, lines 12-25; note that this section constitutes an admitted prior art statement since only that which is old and/or known is disclosed);

a first changing section that changes a monitoring timing of the second communication protocol (Fig. 4; Background Art: page 2, lines 8-24; page 16, line 18 through page 17, line 3; note that as a result of an idle handoff in the CDMA2000 1x system (the second communication protocol) the timing of system monitoring may change); and

a second changing section that changes a monitoring timing of the first communication protocol by communicating with the base station when the first changing section changes the monitoring timing of the second communication protocol (Fig. 4; Background Art: page 2, lines 8-24; page 16, line 18 through page 17, line 3; note that as a result of an idle handoff in the CDMA2000 1x system (the second communication protocol) the timing of system monitoring may change; and in this case, the timing of monitoring the 1xEVDO system (the first communication protocol) must be changed).

AAPA's embodiment discussed above (i.e., Figs. 3A-3B and 4) fail to specifically disclose wherein the setting section does not set the suspend time after the second changing section changes the monitoring timing of the first communication protocol by communicating with the base station.

In the alternate embodiment of Fig. 3C, which as explained above constitutes an admission of prior art, it is shown a timing chart of a case where a suspend time is not set. That is, AAPA discloses wherein the setting section does not set the suspend time (Fig. 3C; page 14, lines 11-12; note that this section constitute an admitted prior art statement since only that which is old and/or known is disclosed).

Furthermore, AAPA's Figure 4 shows that after the second changing section changes the monitoring timing of the first communication method protocol by communicating with the base station, the 1xEVDO system is in the active state. Figs. 3A-3C show conventional timing charts showing processing performed in the 1xEVDO system (see page 7, lines 16-18 of original specification and *Response to Arguments* section above). Note that all of the timing charts of figures 3A to 3C commence in the active state (i.e., "comm" state).

One of ordinary skill in this art at the time of invention by appellant, being given AAPA's Figures 3A to 3C and 4, would reasonably recognize that any of the situations presented in Figures 3A to 3C would apply after the 1xEVDO system is in the active state, which occurs, according to figure 4, after the second changing section changes the monitoring timing of the first communication method by communicating with the base station.

Therefore, it would have been obvious to one of ordinary skill in this art at the time of invention by Appellant to, after the second changing section changes the monitoring timing of the first communication method of AAPA Figure 4, not set the suspend time as suggested by AAPA's Figure 3C for the advantages of performing any conventional processing performed in the 1xEVDO system (see page 7, lines 16-18 of original specification and *Response to Arguments* section above) and immediately shifting to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power.

Regarding claim 4, AAPA discloses the wireless communication terminal according to claim 3 (see above), wherein the first communication protocol is a 1x Evolution Data Only system (Fig. 4; (Background Art: page 1, line 25 through page 2, line 7) and the second

communication protocol is a Code Division Multiple Access 2000 1x system (Fig. 4; (Background Art: page 1, line 25 through page 2, line 7)).

Regarding claims 7-8, which recites a method version of claims 3-4, see rationale as discussed above, i.e., claims 7-8 are rejected with the same grounds and for the same reasons/motivations explained above.

#### **(10) Response to Argument**

Appellant argues that:

- i) There's no admission that Fig. 3C is Prior Art and that the description, when properly viewed in light of the specification, provides that a non-zero "suspend time" is conventional; whereas Fig. 3C illustrates a timing chart of a system without the conventional suspend time (page 14, Section I-A of brief).

Examiner Answers:

Appellant's original specification (page 7), under the "Brief Description of the Drawings" section, clearly stipulates that "Figs. 3A to 3C are timing charts showing processing performed in the 1xEVDO system during a conventional suspend time". Therefore, the specification explicitly states that Fig. 3C is conventional; thus, an admission that Fig. 3C is prior art. In addition, other portions of the original specification further support the Examiner's position. For example, page 13, lines 12-13, and page 14, line 11 through page 15, line 1, state that Figs. 3A to 3C show timing charts of communications using the suspend time in the 1xEVDO system and Fig. 3C is a timing chart of a case where a suspend time is not set. Furthermore, the specification makes clear that when the suspend time is not set, a throughput of data communication is deteriorated when the state of the radio wave is not good (page 14, last paragraph of original specification).

This statement raises the following question: if not setting the suspend time was not prior art, as Applicant intends to argue, then how come not setting the suspend time was understood by those of ordinary skill in the art to deteriorate data communication? This is clearly contradictory to Applicant's argument that Fig. 3C is not prior art and is therefore, an admission that not setting the suspend time (as in Fig. 3C) is prior art, because the specification makes it clear that not setting the suspend time was understood by those in the art to deteriorate data communication. "Knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution." *In re Noyima*, 509 F.2d 572.

Appellant argues that:

- ii) The Examiner's assertion is beyond the scope of the "admission" and that the Examiner's entire position is based on appellant's figure description alone, without considering the specification in its entirety, as a whole, and accordingly, the Examiner has failed to meet the legal requirement for establishing Fig. 3C as prior art (pages 15-16, sections I-B of brief).

Examiner Answers:

The Examiner's position is that Fig. 3C is prior art is not solely based on appellant's figure description alone. Other portions of the specification also provide support for the Examiner's position. For example, page 13, lines 12-13, and page 14, line 11 through page 15, line 1, state that Figs. 3A to 3C show timing charts of communications using the suspend time in the lxEVDO system and Fig. 3C is a timing chart of a case where a suspend time is not set. Furthermore, the specification makes clear that when the suspend time is not set, a throughput of data communication is deteriorated when the state of the radio wave is not good (page 14, last



paragraph of original specification). This statement raises the following question: if not setting the suspend time was not prior art, as Applicant intends to argue, then how come not setting the suspend time was understood by those of ordinary skill in the art to deteriorate data communication? This is clearly contradictory to Applicant's argument that Fig. 3C is not prior art and is therefore, an admission that not setting the suspend time (as in Fig. 3C) is prior art, because the specification makes it clear that not setting the suspend time was understood by those in the art to deteriorate data communication. Therefore, the Examiner considered everything appellants have said about what is prior art to determine the exact scope of their admission, including the specification and the record as a whole; thus, meeting the legal requirement for establishing Fig. 3c as prior art.

Appellant's argues that:

- iii) the specification unequivocally establishes that Fig. 3C is not prior art, citing that the specification provides that a conventional system includes "a suspend time" in the operation (page 7, lines 16-17), that original claim 4 provides "the setting section does not set the suspend time in a case..", and that additional support can be found in the background section indicating that the prior art 1xEVDO system has a non-zero suspend time and that only in the present invention, the suspend time is not set; thus, instead of examining the claims as clearly stated in the specification, the Examiner seize upon a generality within the specification, did not examine the record as a whole, and failed to meet the requirement legally required to establish that Fig. 3C is prior art by admission (pages 16-17 of brief).

Examiner Answers:

A statement that the conventional system includes “a suspend time” cannot be basis for stating that “not setting the suspend time” is not conventional. To the contrary, Appellant’s original specification (page 7), under the “Brief Description of the Drawings” section, clearly stipulates that “Figs. 3A to 3C are timing charts showing processing performed in the IxEVDO system during a conventional suspend time”. Therefore, the specification explicitly states that Fig. 3C is conventional; thus, an admission that Fig. 3C is prior art. In addition, relying on original claim 4 for showing that “not setting the suspend time” is not prior art is not found persuasive because claim 3, from which claim 4 depends also claims the step of “setting the suspend time”, which has been clearly demonstrated to be an admission of prior art. Note that the original specification (page 17, last paragraph) states that the wireless communication terminal of the present embodiment of the invention is configured such that, in order to solve the problem, the suspend time of the IxEVDO system is set **as the related art** in the event of unexpected termination of communication such as instantaneous interruption of a radio wave during data communication of the IxEVDO system; and such that the suspend time is not set when the processing for communication with the base station has ended properly. The arguments do not explain why certain portions of the admissions should be delineated from others. Appellants do not explicitly provide such a line of demarcation or otherwise affirmatively state that statements that follow the “and such that the suspend time is not set” statement are not admitted as prior art. Appellants failed to put forth a supportable argument explaining why certain statements should be parsed out from the “Brief Description of the Drawings” section as non-admitted facts. Furthermore, other portions of the specification also provide support for the

Examiner's position. For example, page 13, lines 12-13, and page 14, line 11 through page 15, line 1, state that Figs. 3A to 3C show timing charts of communications using the suspend time in the IxEVDO system and Fig. 3C is a timing chart of a case where a suspend time is not set. Moreover, the specification makes clear that when the suspend time is not set, a throughput of data communication is deteriorated when the state of the radio wave is not good (page 14, last paragraph of original specification). This statement raises the following question: if not setting the suspend time was not prior art, as Applicant intends to argue, then how come not setting the suspend time was understood by those of ordinary skill in the art to deteriorate data communication? This is clearly contradictory to Applicant's argument that Fig. 3C is not prior art and is therefore, an admission that not setting the suspend time (as in Fig. 3C) is prior art, because the specification makes it clear that not setting the suspend time was understood by those in the art to deteriorate data communication. Therefore, the specification clearly establishes that Fig. 3C is prior art and the Examiner considered everything appellants have said about what is prior art to determine the exact scope of their admission, including the specification and the record as a whole; thus, meeting the legal requirement for establishing Fig. 3c as prior art.

Appellant argues that:

- iv) Appellant should be allowed to rebut the presumption of "Prior Art", requesting the Board to allow appellant to overcome the presumption that Fig. 3C being prior art by appellant's affidavit or declaration.

Examiner Answers:

No affidavit or declaration has been made of record during prosecution of the application.

Appellant argues that:

- v) Fig. 3C teaches away from the proposed modification, given that the specification at page 14, line 24 states in reference to Fig. 3C, "specifically, when the suspend time is not set, a throughput of data communication is deteriorated when the state of the radio wave is not good" and thus, the specification makes clear that not setting the suspend time was understood by those in the art to deteriorate data communication and thus was to be avoided (pages 18-19 of brief).

Examiner Answers:

It has been asserted that "disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or non-preferred embodiments". *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). The statement that "a throughput of data communication is deteriorated" is specific to the condition that the radio wave is not good. There is no indication in the specification that a throughput of data communication is deteriorated in all conditions, including when the radio wave is good. Although not setting the suspend time would deteriorate communication when the state of the radio wave is not good, as applicant intends to argue, it nevertheless provides the advantage of immediately shifting to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings." *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). The fact that Applicant does not set the

suspend time for a different purpose (to not impact the communication performance) does not alter the conclusion that not setting it would be *prima facie* obvious from the purpose disclosed in the references (to immediately shift to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power). “Knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution.” *In re Noyima*, 509 F.2d 572.

Appellant argues that:

- vi) since the primary purpose of a communication device is to enable communication, practitioners would not have been motivated to not set a suspend time and the Office’s stated motivation “conserving battery power” would not have been motivated the artisans in the art (pages 18-19 of brief).

Examiner Answers:

Although not setting the suspend time would deteriorate communication when the state of the radio wave is not good, as applicant intends to argue, it nevertheless provides the advantage of immediately shifting to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. See, e.g., *In re Kahn*, 441 F.3d 977, 987, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). One of ordinary skill in the art need not see the identical problem addressed in a prior art reference to be motivated to apply its teachings.” *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972). The fact that Applicant does not set the suspend time for a different purpose (to not impact the communication performance) does not alter the conclusion that not setting it

would be *prima facie* obvious from the purpose disclosed in the references (to immediately shift to the sleep state just after the wireless communication terminal detects interruption (AAPA: page 14, lines 11-19), thus, conserving battery power). “Knowledge of a problem provides a reason or motivation for workers in the art to apply their skill to its solution.” *In re Noyima*, 509 F.2d 572. See also *KSR*, 127, at 1742 (“One of the ways in which a patent’s subject matter can be proved obvious is by noting that there existed at the time of invention a known problem for which there was an obvious solution encompassed by the patent’s claims.”).

Appellant argues that:

vii) the claimed invention produces unexpected and fruitful results contrary to the prior art's teaching (page 19, last paragraph of brief).

Examiner Answers:

MPEP 7016.01(c) states that a showing of unexpected results must be based on evidence, not argument or speculation. *In re Mayne*, 104 F.3d 1339, 1343-44, 41 USPQ2d 1451, 1455-56 (Fed. Cir. 1997). Appellants have not presented any evidence showing that not setting the suspend time would not impact the communication performance. Due to the absence of tests comparing appellant's communication performance when not setting the suspend time with those of the prior art, it is concluded that appellant's assertions of unexpected results constitute mere argument.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/MARIVELISSE SANTIAGO-CORDERO/  
Primary Examiner, Art Unit 2617

Conferees:

/Jinsong Hu/  
Supervisory Patent Examiner, Art Unit 2617

/Charles N. Appiah/  
Supervisory Patent Examiner, Art Unit 2617